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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,363	08/28/2001	George Emil Sakoske	DMCC 48820	9177

7590 11/10/2003

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EXAMINER	
PADGETT, MARIANNE L	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/941,363	Applicant(s) Sakoske et al
	Examiner M. L. Padgett	Group Art Unit 1762

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 8/6/03.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-33 + 58-59 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-33 + 58-59 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)–(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)–(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO–1449, Paper No(s). _____

☐ Interview Summary, PTO–413

☐ Notice of Reference(s) Cited, PTO–892

☐ Notice of Informal Patent Application, PTO–152

☐ Notice of Draftsperson's Patent Drawing Review, PTO–948

☐ Other _____

Office Action Summary

1. For future reference, when claims are canceled on is not suppose to reprint out the whole claim.

2. In the amendments to independent claims 1 and 19, it is noted that in the screen printing limitation, the phrasing "comprises a single layer of...material..." is an open ended requirement, such that the laser ablation portion must contain at least the claimed single layer, but may also or is not excluded from containing any number of other layers besides one of screen printed material.

The term "crystal seed powder" was found used in paragraphs [0022], [0030], and [0034], where the last gives examples of materials, but none discuss crystallinity or provided a definition as described by applicant on p.9 of the 8/6/03 response, however as it is reasonable to interpret the phrase as described, i.e. comprising crystalline particles and facilitating crystallization and solidification of the screened material during firing, the description is considered to provide file wrapper esstopple for the limitation's meaning.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of

each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-2 and 9-10 remain rejected under 35 U.S.C. 102(b) as being clearly anticipated by Heyman et al (4,327,283).

Claims 7-8, 17-18 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heyman et al, as discussed in section 7 of paper#3, mailed April 14, 2003.

Heyman et al teaches 2 alternative techniques for removing coating material, the use of abrasive particles as cited by applicant on p.9 of their response OR the relevant technique via laser ablation. Applicant's discussion of the alternative that is not using a laser is not convincing for removing the teachings that do use laser from consideration. Furthermore, the citation of col.2, lines 5-11 selectively leaves out lines 13-15, which further discuss the presence of an under-coating, which is may or may not be removed, but is not removed through to the surface of the substrate, i.e. the substrate is not damaged. As applicant's claims use "comprising" language for both the overall method, and for the ablation portion, the presence of this underlying layer is consistent with the claims as written, since while a single layer for ablation must be present, any other number of layers may also "comprise" the ablation portion.

It is noted that while Heyman et al (283) does not discuss "crystal seed powder" in the claims, none need be present (zero weight%) and Heyman et al do teach the use of inorganic silicate, where upon heating or firing, the silicates of the coating and body integrate with one another (col. 3, line 68-col. 4, line 3), which is consistent with applicant's description of the meaning of crystal seed powder and the materials indicated in their specification.

With respect to the new claim 58 limitations, the decorative portion and laser ablation portion being "separated from each other" does not say how they are so separated. Heyman et al's underlaying and overlaying layers are distinct separate layers, hence can be considered read on this claim.

Alternatively, spaciously separate areas on which for example decorative borders are deposited, are an obvious variation dependent on whether of not further or more elaborate ornamentation is desired, i.e. a decorative design choice.

5. Claims 11-16, 19-20, 25-33 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heyman et al as applied to claims 1-2, 7-10, 17-18 and 58 above, and further in view of Axtell, III et al (6,238,847 B1) as applied in section 8, of paper #3 mailed 4/14/2003.

6. Applicant's arguments filed August 6, 2003 and discussed above have been fully considered but they are not persuasive.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M L. Padgett whose telephone number is 703-308-2336 or after mid December (571) 272-1425. The examiner can normally be reached on Monday-Friday from 8:30 am to 4:30 pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

M. Padgett/lap
November 3, 2003
November 7, 2003

MARIANNE PADGETT
PRIMARY EXAMINER